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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,220	08/13/2001	Brian Minear	010240	2135

7590 12/13/2002

QUALCOMM Incorporated
Attn: Patent Department
5775 Morehouse Drive
San Diego, CA 92121-1714

EXAMINER

HAQ, NAEEM U

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 12/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,220

Applicant(s)

MINEAR ET AL.

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because reference number "34" on page 9, line 16 should be replaced with reference number "84". Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 11, 12, 15, 19, 20, and 25 recite the phrases "...selectively downloading...", "...selectively transmitting...", and "...selectively communicating..." It is unclear what these phrases mean. For examination purposes, the examiner will assume that these terms are synonymous with the terms "downloading", "transmitting", and "communicating". In addition, claim 11 invokes 112, sixth paragraph by reciting the phrases "wireless communication means for...", "application download means for...", and "an accounting means for..." However, the specification does not provide structural support for these limitations. For this reason claim 11 is rendered indefinite. For examination purposes, the examiner will assume that these limitations refer to any structure capable of performing the recited functions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Javed (US PG PUB 2001/0036271 A1) in view of Munyan (US Patent 5,761,485).

Referring to claims 1, 4-7, 11, 12, 15-19, 20, and 25, Javed teaches a system for providing downloadable subscription-based software to one or more wireless devices, comprising:

- one or more wireless devices, each wireless device in selective communication with a wireless network and selectively downloading one or more subscription-based software applications to be executable on the wireless device, (page 1, section [0015]; page 2, section [0016]; page 3, section [0045]; page 7, section [0077]);
- one or more application download servers, each application download server selectively communicating with the one or more wireless devices across the wireless network and downloading to the wireless devices at least one subscription-based software application, each application download server generating subscription-based application download data for each subscription-based software application downloaded by a

wireless device therefrom (page 3, sections [0042], [0043]; page 4, section [0049], [0050]);

- an accounting module to account for the use of subscription-based software applications by each wireless device, the accounting module receiving subscription-based application download data from the one or more application download servers and subscription-based application deletion data from each wireless device (page 4, section [0050], [0052]).

Javed does not teach deleting a subscription-based application from a wireless device. However, Munyan teaches deleting a subscription-based application from a wireless device (column 8, lines 58-65). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Munyan into the system of Javed. One of ordinary skill in the art would have been motivated to do so in order to allow a user to make room for more selections to be downloaded, as taught by Munyan (column 8, lines 58-60). Javed and Munyan do not teach that the accounting is based upon the combination of the subscription-based software application download data and the subscription-based application deletion data. However this limitation is rendered obvious over Javed and Munyan. Both Javed and Munyan teach downloading subscription-based services over a wireless network. Furthermore, Javed teaches that the subscription-based service can be rented, and Munyan teaches that the subscription-based service can be deleted from the wireless device. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to allow a user to notify the VISP or the VPOP (i.e.

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application server) that the rental period was over by transmitting deletion data to the server. One of ordinary skill in the art would have been motivated to do so in order to stop charging a user for an expired rental subscription.

Referring to claims 2, 3, 13, 14, and 21-24, Javed teaches that the accounting module is resident on the application download server from which a subscription-based software application was downloaded (Figure 2, items "224" and "234"; page 3, section [0046]).

Referring to claims 8-10, Javed and Munyan do not explicitly teach that the device is a cellular telephone, PDA, or pager. However, these devices are old and notoriously well known in the art. Furthermore, Javed teaches that his system maybe implemented on other architectures that do not depart from the spirit and scope of the invention (page 3, section [0045]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to implement the system of Javed and Munyan on a cellular telephone, PDA, or pager. One of ordinary skill in the art would have been motivated to do so in order to implement the system of Javed and Munyan on devices that are well known and commercially successful.

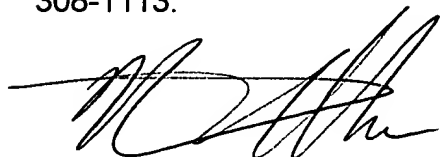
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703)-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-305-7687 for regular communications and (703)-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1113.



Naeem Haq, Patent Examiner
Art Unit 3625



WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
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December 9, 2002